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OFFICE OF PETITIONS

In re Application of	: DECISION DISMISSING PETITION
VEECH, RICHARD L.	: UNDER 37 CFR 1.78(a)(3)
Application No. 10/763,393	:
Filed: 01/26/2004	:
Attorney Docket No. 604-707	:

This is a decision on the petition under 37 C.F.R. 1.78(a)(3), filed June 17, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP 201.06(d). Applicant should review the claims submitted to ensure that a reference is made to the first application and to every intermediate application.

Specifically, the Office notes that Application Nos. 10/153,873, 09/843,694, and 09/397,100 claim the benefit of prior-filed provisional application No. 60/040,858 under 35 U.S.C. 119(e). However, Application Nos. 10/153,873, 09/843,694, and 09/397,100 were not filed within 12 months of the filing date of prior-filed provisional application 60/040,858 filed March 17, 1997. Thus, Application Nos. 10/153,873, 09/843,694, and 09/397,100 improperly claim the benefit of prior-filed provisional application 60/040,858.

The Office reminds applicant that when a later-filed application is claiming the benefit of a prior-filed provisional application under 35 U.S.C. 119(e), the nonprovisional application must be filed not later than 12 months after the date on which the provisional application was filed. MPEP 201.11(II)(A). If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the nonprovisional application may be filed on the next succeeding business day. See 35 U.S.C. 21(b), 37 CFR 1.7(b), and MPEP 201.04(b) and 505. An applicant may claim the benefit of a provisional application by claiming the benefit of an intermediate copending nonprovisional application. The later-filed application must claim the benefit of the intermediate nonprovisional application under 35 U.S.C. 120, 121, or 365(c); the intermediate application must be filed not later than 12 months after the filing date of the provisional application; and both the later-filed application and the intermediate application must claim the benefit of the provisional application under 35 U.S.C. 119(e). MPEP 201.11(II)(A).

Before a petition under 37 CFR 1.78(a)(3) can be granted in this application, petitioners must correct the error in Application Nos. 10/153,873, 09/843,694, and 09/397,100.

Therefore, applicant must: (1) file a petition under 37 CFR 1.78(a)(6) and a petition to revive under 37 CFR 1.137(b) in Application No. 10/153,873; (2) file a petition under 37 CFR 1.78(a)(6) and a petition to revive under 37 CFR 1.137(b) in Application No. 09/843,694; (3) file a completed Certificate of Correction (and certificate of correction fee)¹ in Application No. 09/397,100 (now Patent No. 6,323,237) correcting the claim for benefit of prior-filed provisional application 60/040,858; and (4) file a renewed petition under 37 CFR 1.78(a)(3) in the present application (No. 10/763,393) accompanied by a copy of the completed Certificate of Correction in Application No. 09/397,100 to demonstrate that applicant perfected the priority claim in that application. No additional fee is required for filing a renewed petition under 37 CFR 1.78(a)(3)

¹ See MPEP 1481.03(II).

in this application. The Office notes that decisions granting the petitions under 37 CFR 1.78(a)(6) and 1.137(b) in Application Nos. 10/153,873 and 09/843,694, as well as a Certificate of Correction in Application No. 09/397,100 are pre-requisites for a decision on any renewed petition in this application (No. 10/763,393).

The petition fee of \$1,410.00 will be charged to the Deposit Account as authorized.

Upon filing the above-mentioned petitions, applicant should include a cover letter clearly directing them to the Attention of Senior Petitions Attorney Christina Tartera Donnell.

Correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
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By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Correspondence may also be submitted via the Electronic Filing System of the USPTO.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3211.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Conferees: Joni Chang and Eugenia Jones, Senior Legal Advisors, Office of Patent Legal Administration

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

VEECH, Richard L.

Atty. Ref.: 604-707; Confirmation No. 4584

Appl. No. 10/763,393

TC/A.U. 1809

Filed: January 28, 2004

Examiner: Thomas, Timothy P.

For: THERAPEUTIC COMPOSITIONS

* * * * *

June 17, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 C.F.R. §1.78(A)(3)

In response to the Official Action of March 17, 2008, Applicant hereby petitions under 37 C.F.R. §1.78(a)(3) for acceptance of an unintentionally delayed benefit claim under 35 U.S.C. §119(e), 120, 121 and 365(c). The present petition is accompanied by an Amendment and Response which presents the requested cross-reference to the prior applications.

The entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional.

The requisite fee and/or surcharge for this petition are to be charged to our deposit account number 14-1140.

10/30/2008 GARIAS 00000011 141140 10763393
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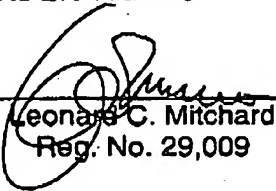
VEECH, Richard L.
Appl. No. 10/763,393
June 17, 2008

Favorable action on the present petition is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


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